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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,335	12/30/2003	Suzanne Walker Kahne	4555-121 US	8137

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EXAMINER

MARTIN, PAUL C

ART UNIT PAPER NUMBER

1655

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/748,335

Applicant(s)

KAHNE ET AL.

Examiner

Paul C. Martin

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

S.O.D

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a method of identifying a compound that modulates the ability of a glycosyltransferase to bind a substrate, classified in class 435, subclass 193.
- II. Claims 12-18, drawn to a composition that inhibits the ability of a glycosyltransferase to bind a substrate, classified in class 435, subclass 184.
- III. Claims 19 and 20, drawn to a method of controlling proliferation of bacteria, classified in class 435, subclass 32.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions employ different method steps, wherein each respective group does not require the particulars of any other group.

One would therefore not have to practice the various methods at the same time to practice just one method alone, for example; Group I does not require the particulars of Group III, i.e., the specification that the compound inhibit peptidoglycan synthesis in bacteria.

Inventions I and II are related as process of identifying and product identified. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to identify an other and materially different product or (2) that the product as claimed can be identified by another and materially different process (MPEP § 806.05(f)). In the instant case, the process of identifying a compound that modulates the ability of a glycosyltransferase to bind a substrate could be used in the identification of a compound that modulates the activity of any other enzyme, such as a hydrolase.

Inventions II and III are related as product identified and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the identified product as claimed can be practiced with another materially different product or (2) the identified product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the method of controlling the proliferation of bacteria or treating a bacterial infection in an animal by administering an effective amount of a compound that inhibits the ability of a glycosyltransferase to bind a substrate can be practiced with another materially different product, such as moenomycin.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Claims 12-20 describe patentably distinct inventions. Claims 12 and 19 cite a core structure including variables  $R^1$ ,  $R^2$ ,  $R^3$ , J, L, Q and M; wherein each of  $R^1$ ,  $R^2$ ,  $R^3$ , J, L, Q and M may comprise vastly different constituents. Further,  $R^1$ ,  $R^2$ ,  $R^3$ , J, L, Q and M define their side chains as comprising sub-variables  $R^{1a}$ ,  $R^{1a'}$ ,  $R^{1b}$ ,  $R^{1c}$ ,  $R^{1d}$ ,  $R^{1e}$ ,  $R^{1f}$ ,  $R^{2a}$  and  $R^{2b}$ . Each permutation (of which there are potentially millions, and therefore not specifically recited in this Restriction Requirement) of chemical substance is considered unique and distinct in that the only commonality of each substance is the core benzene ring. Each distinct invention possesses a unique structure and would provide, chemically, for a different function and reactivity with regard to any other Invention. Further, the enormity of potential permutations of this chemical structure would provide for a serious burden on the Examiner. Thus, Applicant is asked to elect a single Invention which corresponds to the structure as recited in claims 12 and 19; i.e., a structure with *one constituent per variable* for examination on the merits.

Further, if Applicant chooses an Invention as described by claims 13 and 14, these Inventions are not accompanied by their chemical structure. Thus, Applicant is asked to provide the chemical structure of any Invention chosen from claims 13 or 14 and describe how they relate to the chemical structures as indicated by claims 12 and 19 (i.e., provide for specific variables and sub-variables).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul C. Martin whose telephone number is 571-272-3348. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Martin  
Examiner  
Art Unit 1655

8/19/05

PATRICIA LEITH  
PRIMARY EXAMINER  
